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OFFICE OF PETITIONS

In re Application of : DECISION ON PETITION
Sherer, et al. :
Application No. 09/488,942 :
Filed: 20 January, 2000 :
Attorney Docket No. 1112-US-CIP :
:

This is in response to the petition filed on 5 December, 2008, and considered under 37 C.F.R. §1.47(a).

The petition as considered under 37 C.F.R. §1.47(a) is **DISMISSED**.

A grantable petition under 37 CFR 1.47(a) requires: (1) petition and fee; (2) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings); (3) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; and (4) a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address.

BACKGROUND

The record indicates:

The instant application was filed on 21 January, 2000, without, *inter alia*, a fully executed oath/declaration.

On 24 March, 2000, the Office mailed a Notice of Missing Parts indicating, *inter alia*, that a fully executed oath/declaration (signed and dated) was required.

On 18 September, 2000, Petitioner (former Counsel) John P. Wagner, Jr. (Reg. No. 35,398) filed a petition with, *inter alia*, an oath/declaration signed by Messrs. Sherer, Connery and Reid on behalf of themselves and the non-signing inventors Niles E. Strohl (Mr. Strohl), Richard

Hausman (M.r Hausman), James P. Rivers (Mr. Rivers) and Cynthia Zikmund (Ms. Zikmund), and no evidence of:

- the presentation (or not) of the entire application to the non-signing inventors;
- as to whether the non-signing inventors had or had not been found; and
- as to the issues of the diligent effort used (or not) to ascertain a reasonably believed to be current/valid/last known address for the non-signing inventors, followed by transmittal of the entire application to them and then their subsequent failure/refusal to sign/join in the declaration.

Moreover, there is an indication that—despite the availability and signing of some of the named co-inventors—former Counsel signed on behalf of the non-signing inventor(s)—a practice that might be appropriate for a petition pursuant to under 37 C.F.R. §1.47(b), but not 37 C.F.R. §1.47(a). Also, by the time the petition was addressed by the Office, there appeared to be new Counsel of Record. Because of the deficiencies in the petition and its support, the petition was dismissed on 24 November, 2008.

On renewed petition filed on 5 December, 2008, Petitioner Richard A. Baker (Reg. No. 48,124) presented an oath/declaration represented to have been executed by all named co-inventors, including the former non-signing co-inventor(s) in compliance with 37 C.F.R. §1.63—and so evidencing their joinder—and Petitioner represented to the Office that the petition was moot.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

CONCLUSION

The instant petition under 37 C.F.R. §1.47 is dismissed as moot.

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

In view of the joinder of the inventor, further consideration under 37 C.F.R. §1.47 is not necessary. This application does not have any Rule 1.47 status and no such status should appear on the record for this file. This application should not be returned to this Office for any further consideration under 37 C.F.R. §1.47.

The instant application is released to the Office of Patent Application Processing (OPAP) for further processing in due course.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2²) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

² The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.